

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1-25 are pending in the present application, with claims 1 and 11 being independent.

Claim Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1-2, 11-12, and 17 Under 35 U.S.C. §102(b) as being anticipated by *Nishio* (US 5,170,273). This rejection is respectfully traversed insofar as it pertains to the presently pending claims.

The Examiner alleges that *Nishio* teaches a first optical fiber transmission path and a second optical fiber transmission path, as recited in the independent claims. *Nishio*, however, fails to teach or suggest that the second optical fiber transmission path has a zero-dispersion wavelength that is different from the first optical fiber transmission path, as recited in the independent claims. The Examiner, however, alleges on page 2 of the outstanding Office Action that this feature is *inherent*.

MPEP 2131 specifically states that to anticipate a claim, the reference must teach every element of the claim. In other words, in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of claim with sufficient clarity to prove its existence in prior art, since this disclosure

requirement presupposes knowledge of one skilled in art of the claimed invention, but such "presumed knowledge does not grant a license to read into prior art reference teachings that are not there," see *Motorola Inc. v. Interdigital Technology Corp.* USPQ2d 1481, 1490 (Fed. Circ. 1997), emphasis added.

Moreover, referring to MPEP 2112 it specifically states, that:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)... "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Emphasis Added.

As such, in view of the above, the Examiner's conclusionary statement that it is "inherent in the wavelength conversion that takes place" that *Nishio* has a second optical fiber transmission path having a zero-dispersion wavelength different from the first optical fiber transmission path is not a proper basis to substantiate an anticipation rejection.

Referring to page 6, lines 4 to 20, of the present application it is taught that a zero-dispersion wavelength of the first optical fiber transmission path is different from the zero-dispersion

wavelength of the second optical fiber transmission path. Furthermore, as disclosed on page 6, line 21, to page 7, line 21, in the present application, and in Figs. 2A, 2B, and 3, it can be readily seen that an optical signal having a multiplexed wavelength λ_1 to λ_n , relative to the zero-dispersion wavelength λ_0 of the first optical transmission path, is transmitted in the first optical fiber transmission path as an optical input signal in the optical repeater. The multiplexed wavelength of the signal is then converted to λ_1' to λ_n' relative to the zero-dispersion wavelength λ_0' of the second optical fiber transmission path by the optical repeater, and the converted signal is output to the second optical fiber transmission path for minimizing the SPM-GVD effect and FWM in the second optical fiber transmission path.

In contrast thereto, *Nishio*, as clearly disclosed in col. 2, lines 40 to 45, and in col. 2, lines 53 to 55, wavelengths of signals in the transmission path between the combiner 120 and the splitter 130 (which the Examiner alleges to be the first optical fiber transmission path) are represented as λ_1 , λ_2 , λ_3 , and the wavelengths of signals in the transmission path between the combiner 121 and the splitter 131 (which the Examiner alleges to be the second optical fiber transmission path), are also represented as λ_1 , λ_2 , λ_3 . Since the input wavelength is matched with the zero-dispersion wavelength of an optical fiber in *Nishio*, the zero-dispersion wavelength of the first optical fiber transmission path

is the same as the zero-dispersion wavelength of the second optical fiber transmission path. Therefore, *Nishio* clearly fails to anticipate the features of at least independent claims 1 and 11, e.g., that the second optical fiber transmission path has a zero-dispersion wavelength different from that of the first optical fiber transmission path.

However, in an effort to expedite the prosecution of the present applications, Applicants have amended independent claims 1 and 11 in an effort to clarify the distinguishing features of the claims.

Claims 2, 12, and 17 are dependent claims, which should be considered allowable at least for depending from an allowable base claim.

Accordingly, in view of the above discussion, Applicants respectfully request that the Examiner withdraw the rejection.

Claim Rejections Under 35 U.S.C. §103

The Examiner rejected claims 3-6 and 18-19 under 35 U.S.C. §103(a) as being unpatentable over *Nishio*. This rejection is respectfully traversed.

In rejection dependent claims 3-6 and 18-19, the Examiner alleges that the features in these claims that are not taught by *Nishio* are well known in the art. Applicants respectfully submit that this is not a proper basis to substantiate an obviousness

rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all of the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

Although the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 3-6 and 18-19, these claims should at least be considered allowable because they depend from an allowable base claim.

Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Martin Geissler (Reg. 51,011) at telephone

number (703) 205-8000, which is located in the Washington, DC area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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